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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,350	01/19/2001	Takashi Suda	1046.1231 (JDH)	7142

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EXAMINER

TIV, BACKHEAN

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,350

Applicant(s)

SUDA, TAKASHI

Examiner

Backhean Tiv

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Claims 1-20 are pending in this application. This is a response to the RCE filed on 3/11/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1-20, recites the limitation, "the state of references by a user to Web sites", it is unclear what the applicant means. Does the applicant mean that the user is monitoring the websites? or Does the applicant mean the user access the website in which the monitoring section monitors the state of references of those websites?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,19,20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,933,604 issued to Inakoshi.

As per claim 1, Inakoshi teaches an apparatus for managing addresses of Web sites, comprising: an address list containing addresses of Web sites(fig.19, element 60); a monitoring section monitoring the state of references by a user to Web sites(col.2,lines 5-9); and an updating section updating the contents of said address list according to the state of references by a user monitored by said monitoring section(col.2,lines 5-13).

As per claim 2, an apparatus for managing addresses of Web sites according to Claim 1, further comprising a connection section accessing to an address contained in said address list in case the address is designated(fig.19).

Claim 19 is of the same scope as claim 1. Claim 1 recites an apparatus while claim 19 recites a method, therefore is rejected based on the same rationale (see claim 1 rejection).

Claim 20 is of the same scope as claim 1. Claim 1 recites an apparatus while claim 20 recites a recording medium, therefore is rejected based on the same rationale (see claim 1 rejection).

Claims 1,2,19,20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,055,570 issued to Nielsen.

As per claim 1, Nielsen teaches an apparatus for managing addresses of Web sites, comprising: an address list containing addresses of Web sites(Fig.7); a monitoring section monitoring the state of references by a user to Web sites(Abstract,col.4, line 60-col.5, line 20); and an updating section updating the contents of said address list according to the state of references by a user monitored by said monitoring section(Abstract,col.4, line 60-col.5, line 20).

As per claim 2, an apparatus for managing addresses of Web sites according to Claim 1, further comprising a connection section accessing to an address contained in said address list in case the address is designated(Fig.7, col.5, lines 60-col.6, line 5).

Claim 19 is of the same scope as claim 1. Claim 1 recites an apparatus while claim 19 recites a method, therefore is rejected based on the same rationale (see claim 1 rejection).

Claim 20 is of the same scope as claim 1. Claim 1 recites an apparatus while claim 20 recites a recording medium, therefore is rejected based on the same rationale (see claim 1 rejection).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,933,604 issued to Inakoshi in view of US Patent 6,631,496 issued to Li et al. (Li).

Inakoshi teaches all the limitations of claim 1, however does not teach as per claim 3, an apparatus for managing addresses of Web sites according to Claim 1, wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value.

Li teaches an apparatus for managing addresses of Web sites wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value(fig 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Inakoshi, the monitoring system to add wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined

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threshold value as taught by Li, in order to allow a user to build and organize a large collection of bookmarks(col.1,lines 53-55).

One ordinary skilled in the art at the time of the invention would combine Inakoshi, and Li to provide a system to keep track of websites that the user has bookmarked.

As per claim 4, an apparatus for managing addresses of Web sites according to Claim 1, wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section deletes, from said address list, any of the addresses in said address list with an access frequency lower than a predetermined threshold value(Li, col.11,lines 29-34).Motivation to combine set forth in claim 3.

As per claim 5, an apparatus for managing addresses of Web sites according to Claim 1, wherein, if the number of times access failure has occurred with respect to one of the addresses contained in said address list becomes equal to a predetermined threshold value, said updating section deletes the address from said address list(Li, fig.19). Motivation to combine set forth in claim 3.

As per claim 6, an apparatus for managing addresses of Web sites according to Claim 3, wherein the access frequency with respect to each of the Web sites is updated each time access to the Web site results in success, and wherein, when the access frequency is updated, said updating section makes a determination whether or not the access frequency has reached the predetermined threshold value(Li, fig.19). Motivation to combine set forth in claim 3.

As per claim 7, an apparatus for managing addresses of Web sites according to Claim 5, wherein said updating section has a line is connected for reference to the Web sites, and wherein, if no input is supplied over a predetermined time period with respect to reference to any of the Web sites, said updating section tries to access each of the addresses contained in said address list, and deletes the address from said address list if the number of times failure has occurred continuously becomes equal to a predetermined threshold value by failure of said trial(Li, fig.19,). Motivation to combine set forth in claim 3.

As per claim 8, an apparatus for managing addresses of Web sites according to Claim 1, further comprising a supply section supplying a user with a setting window to enable the user to set the predetermined threshold value(Li, fig.16 and 19, col. 14, lines 30-34). Motivation to combine set forth in claim 3.

Claims 9, 10, 11 are of the same scope as claim 8, therefore are rejected based on the same rationale(see claim 8 rejection). Motivation to combine set forth in claim 3.

As per claim 12, an apparatus for managing addresses of Web sites according to Claim 1, wherein said updating section is activated when an operating system controlling said address management apparatus is activated(Li, col.3,lines 3-5). Motivation to combine set forth in claim 3.

Claims 13 and 14 are of the same scope as claim 12, therefore are rejected based on the same rationale (see claim 12 rejection). Motivation to combine set forth in claim 3.

As per claim 15, an apparatus for managing addresses of Web sites according to Claim 1, wherein the access frequency is the number of occurrences of access in a unit number of days, and said updating section is activated when the date is changed(Li, fig.19). Motivation to combine set forth in claim 3.

Claims 16 and 17 are of the same scope as claim 15, therefore are rejected based on the same rationale as claim 15(see claim 15 rejection). Motivation to combine set forth in claim 3.

As per claim 18, an apparatus for managing addresses of Web sites according to Claim 8, wherein said updating section is activated when the setting of the predetermined threshold value is changed by the user (Li, fig.19). Motivation to combine set forth in claim 3.

Claims 3-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,055,570 issued to Nielsen in view of US Patent 6,631,496 issued to Li et al. (Li).

Nielsen teaches all the limitations of claim 1, however does not teach as per claim 3, an apparatus for managing addresses of Web sites according to Claim 1, wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value.

Li teaches an apparatus for managing addresses of Web sites, wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value(fig 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of Nielsen, the monitoring system to add wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section adds, to said address list, an address with an access frequency reached to a predetermined threshold value as taught by Li, in order to allow a user to build and organize a large collection of bookmarks(col.1,lines 53-55).

One ordinary skilled in the art at the time of the invention would combine Nielsen, and Li to provide a system to keep track of websites that the user has bookmarked.

As per claim 4, an apparatus for managing addresses of Web sites according to Claim 1, wherein said monitoring section records the frequency of access to the address of each Web site as a content of said state of references, and said updating section deletes, from said address list, any of the addresses in said address list with an access frequency lower than a predetermined threshold value(Li, col.11,lines 29-34).Motivation to combine set forth in claim 3.

As per claim 5, an apparatus for managing addresses of Web sites according to Claim 1, wherein, if the number of times access failure has occurred with respect to one

of the addresses contained in said address list becomes equal to a predetermined threshold value, said updating section deletes the address from said address list(Li, fig.19). Motivation to combine set forth in claim 3.

As per claim 6, an apparatus for managing addresses of Web sites according to Claim 3, wherein the access frequency with respect to each of the Web sites is updated each time access to the Web site results in success, and wherein, when the access frequency is updated, said updating section makes a determination whether or not the access frequency has reached the predetermined threshold value(Li, fig.19). Motivation to combine set forth in claim 3.

As per claim 7, an apparatus for managing addresses of Web sites according to Claim 5, wherein said updating section has a line is connected for reference to the Web sites, and wherein, if no input is supplied over a predetermined time period with respect to reference to any of the Web sites, said updating section tries to access each of the addresses contained in said address list, and deletes the address from said address list if the number of times failure has occurred continuously becomes equal to a predetermined threshold value by failure of said trial(Li, fig.19,). Motivation to combine set forth in claim 3.

As per claim 8, an apparatus for managing addresses of Web sites according to Claim 1, further comprising a supply section supplying a user with a setting window to enable the user to set the predetermined threshold value(Li, fig.16 and 19, col. 14, lines 30-34). Motivation to combine set forth in claim 3.

Claims 9, 10, 11 are of the same scope as claim 8, therefore are rejected based on the same rationale(see claim 8 rejection). Motivation to combine set forth in claim 3.

As per claim 12, an apparatus for managing addresses of Web sites according to Claim 1, wherein said updating section is activated when an operating system controlling said address management apparatus is activated(Li, col.3,lines 3-5). Motivation to combine set forth in claim 3.

Claims 13 and 14 are of the same scope as claim 12, therefore are rejected based on the same rationale (see claim 12 rejection). Motivation to combine set forth in claim 3.

As per claim 15, an apparatus for managing addresses of Web sites according to Claim 1, wherein the access frequency is the number of occurrences of access in a unit number of days, and said updating section is activated when the date is changed(Li, fig.19). Motivation to combine set forth in claim 3.

Claims 16 and 17 are of the same scope as claim 15, therefore are rejected based on the same rationale as claim 15(see claim 15 rejection). Motivation to combine set forth in claim 3.

As per claim 18, an apparatus for managing addresses of Web sites according to Claim 8, wherein said updating section is activated when the setting of the predetermined threshold value is changed by the user (Li, fig.19). Motivation to combine set forth in claim 3.

Response to Arguments

Applicant's arguments filed 3/11/05 have been fully considered but they are not persuasive.

The applicant argues that Inakoshi does not teach, "a monitoring section monitoring the state of references by a user to a website." The examiner disagrees, Inakoshi teaches, col.4, lines 31-38, that "resource on the communication network is the target of monitoring is specified at the time of the user request. The monitoring request from the user is sent from the management unit to the monitoring unit." This clearly teaches "a monitoring section monitoring the state of references by a user to a website". This user is requesting a website to be monitored by the monitoring section.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reference can be a connection or access to a website by the user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUPERVISORY PATENT EXAMINER